

### REMARKS

The present application and its claims are directed to a system and method for collection and conversion of document sets and related metadata to a plurality of document/metadata subsets.

### PRIOR ART REJECTIONS

In response to the Examiner's rejection of Claims 1-7, 10, 13-19, 22, 25- 31 and 34 under 35 U.S.C. 103 as being unpatentable over US Patent No. 6,704,733 to Clark et al. ("Clark") in view of US Patent No. 7,039,643 to Sena et al. ("Sena"), the rejection of claims 8-9, 20-21 and 32-33 under 35 U.S.C. 103 as being unpatentable over Clark in view of Sena and further in view of US Published Patent Application No. 2003/0023635 to Justice ("Justice") and the rejection of claims 11-12, 23-24 and 35-36 as being unpatentable over Clark in view of Sena and further in view of US Published Patent Application No. 2004/0201633 to Barsness et al. (hereafter "Barsness"), Applicant traverses the rejections because the examiner has not established a *prima facie* case of obviousness (for the reasons set forth below) and therefore the rejections above are improper and must be withdrawn.

#### Obviousness Standard

Pursuant to MPEP § 2143, to establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and the prior art reference must teach or suggest all the claim limitations. See *M.P.E.P. § 2143*. Also, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

#### Independent Claims 1, 13 and 25

These claims are improperly rejected as being unpatentable over Clark in view of Sena. For purposes of the arguments below, Applicant will refer to the elements of claim 1, but it should be understood that similar arguments apply to claims 13 and 25. In particular, the examiner has not established a *prima facie* case of obviousness because the claim elements "an input module that receives an input file in a particular format, the input module further comprising a module that validates the input file and converts the input file into an intermediate format file", "a storage

device comprising a storage portion that stores the intermediate format file and a storage portion into which a piece of work metadata associated with the input file is stored” and “a conversion module that generates two or more editions of a work having different formats, the two or more editions of the work being generated based on the intermediate format file and the work metadata” are not taught or suggested by Clark or Sena.

**An input module that receives an input file in a particular format, the input module further comprising a module that validates the input file and converts the input file into an intermediate format file**

The examiner has admitted that Clark does not disclose the “intermediate file format”. See *Office Action* at 3-5. The examiner asserts that Sena discloses this aspect (See *Office Action* at pg. 3-4) and cites to Col. 12, lines 22-35 of Sena to support the rejection. The portion cited by the examiner states “Although the intermediate format of the converted media will usually be in Extensible Markup Language (XML), a skilled programmer will realize that different intermediate formats may be more appropriate for other digital media conversions” See *Sena* at Col. 12, lines 22-26. Thus, in Sena, individual media files are converted into the intermediate format as admitted by the examiner when the examiner argues that “Sena provides the benefit of converting authored input files to an intermediate format such that the content *components* are more easily manipulated.” See *Office Action* at pg. 4. However, the final product of the input process in Sena is not stored in the intermediate format file as claimed. Sena converts components of the final product into the intermediate format while the claimed system converts the input file (the entire file) into the intermediate format file and then generates two or more editions of the work (such as a book) based on the file in the intermediate format file.

Therefore, none of the prior art teaches or suggests this element of the claims.

**A storage device comprising a storage portion that stores the intermediate format file and a storage portion into which a piece of work metadata associated with the input file is stored**

The examiner has admitted that Clark does not disclose this element. See *Office Action* at 4-5. The examiner has asserted that Sena discloses this element by citing to Col. 8, lines 49-58 of Sena. However, in the office action, the examiner quoted that portion of Sena, but then

included two sentences (“Files, and accompanying metadata, are stored initially when input to the system to check them for viruses. The file conversion to intermediate files also has storage for the intermediate files”) that appear nowhere in Sena, but it is suggested that these two sentences are part of the disclosure in Sena which they are not.

In any event, the conclusions reached in these two sentences (that Sena discloses metadata and that the intermediate files are stored) is not correct. First, Sena does not contain the term “metadata” does not the concept anywhere.

Second, Sena only stores the output files (*See Sena Col. 7, lines 59-61 - “In step 948 this digital media output is placed in the system server 492 for access by the user or other third parties.”*) See also Sena Figure 5B (that shows the intermediate format at step 942, and conversion out of that format as step 944 and Step 948 is “transformed files placed on server.”) as well as Figure 7 (the digital media conversion and integration module as per Col. 8 line 40), which shows *temporary* file storage 418 interacting only with the Digital Media Input Handler Module 420, and not with the Transformation Module 460.

Sena does disclose “temporary data storage” 424 and “temporary file storage” 418. *See Sena at Col. 7 lines 36-40 - “The user attaches the files to such a prompt either by manual command or a special screen and downloads the files to the temporary storage server 418 in step 922. In step 924 the digital media input files are loaded into the input handler module 420.” and Col. 8 lines 49-53 - “a publishing manager module 450 which controls and schedules the entire process of converting, integrating and publishing and distributes the digital media files 410 412, and 414, and 415 between the modules, temporary file storage 418, and a digital media input handler module 420....”* However, even if the temporary data storage 424 is a separate storage area, the Transformation Module 640 (that generates the intermediate formats) cannot use the temporary data storage 424. *See Sena, Col 10 lines 3-4 - “The digital files are uploaded from the user's computer 350 through the Internet 405 to the temporary data storage 424. The data storage is kept apart from the rest of the modules in case the file is infected with a computer virus.”*

Thus, Sena does not disclose the storage of the intermediate files. Therefore, none of the prior art relied on by the examiner teaches or suggests this claim element.

**A conversion module that generates two or more editions of a work having different formats, the two or more editions of the work being generated based on the intermediate format file and the work metadata**

The examiner cites to Clark for disclosure of this element. However, since neither Clark nor Sena disclose the intermediate format file and the work metadata (as set forth above), neither Clark nor Sena teach or suggest this claim element.

Therefore, for these reasons, the examiner has not established a prima facie case of obviousness and the rejection of independent claims 1, 13 and 25 should be withdrawn.

Claims 2-12, 14-24 and 26-36

These claims depend from the independent claims above and the examiner has not established a prima facie case of obviousness for these claims for at least the same reasons as the independent claims.

With respect to claims 10, 22 and 34, the examiner has not established a prima facie case of obviousness for this claim because the combination of Clark and Sena do not teach or suggest “wherein an edition of the work further comprises an edition containing a subset of the work metadata associated with the intermediate format file” as set forth in claims 10, 22 and 34. The examiner asserts that Clark teaches or suggests this claim at Col. 7, line 63 – Col. 9, line 43. *See Office action at pp. 9-10.* However, Clark discloses “As shown, *after generation of a title in the selected distribution format(s)*, the process 240 may store 260 the title's metadata in a database of metadata corresponding to different titles. As described below, this stored metadata can be used to *construct a catalog of titles for a retailer.*” *See Clark at Col. 7 lines 63–66.* Thus, in Clark, the system may generate metadata for an edition (the title) after the title is generated. However, Clark does not teach or suggest “an edition containing a subset of the work metadata” and does not disclose any mechanism for creating a work that contains subsets of the metadata. Therefore, the examiner has not established a prima facie case of obviousness for claims 10, 22 and 34 for at least this additional reason.

CONCLUSION

In view of the above, it is respectfully submitted that Claims 1-36 are allowable over the prior art cited by the Examiner and early allowance of these claims and the application is respectfully requested.

The Examiner is invited to call Applicant's attorney at the number below in order to speed the prosecution of this application.

The Commissioner is authorized to charge any deficiencies in fees and credit any overpayment of fees to Deposit Account No. 07-1896.

Respectfully submitted,

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